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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,398	02/21/2001	Zhenya Alexander Yourlo	169.1995	5425

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EXAMINER

LY, ANH

ART UNIT	PAPER NUMBER
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2172

11

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,398

Applicant(s)

YOURLO ET AL.

Examiner

Anh Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) #7 & #8. 6) ☐ Other: _____

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DETAILED ACTION

1. This Office Action is response to Applicants' response filed on 11/21/2003.
2. Claims 15-16 have been added.
3. Claims 1-16 are pending in this application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-3 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,671,818 issued to Mikurak.

With respect to claim 1, Mikurak discloses a Portable Customisable data Filter and Interface (PCFI) comprising a programmable smartcard adapted to store at least a data filter parameter, and further adapted to provide a user interface by means of spatially distributed user selectable icons made visible on a surface of the smartcard (custom software interface and graphical user interface (GUI): col. 2, lines 55-67 and col. 9, lines 33-48; also see abstract; a smart card is programmed: col. 256, lines 15-18) and icon for user to select: col. 14, lines 61-67 and col. 78, lines 4-11 and lines 24-38);

a reader means adapted to interface with said PCFI, and further adapted to discriminate an icon on an inserted said smartcard selected by a user (smartcard reader for inserting the smartcard: col. 256, lines 25-30);

and database processing means adapted to interface with the reader means, said database processing means being (a) responsive to data filter parameter and detected icon selection (selectable icon: col. 78, lines 4-38 and col. 96, lines 35-60); and (b) adapted to establish the correspondingly reduced search space depend upon said filter parameter, and wherein said one or more of the database search and the data item selection is performed using the selectable icons (searching database based on the selectable icon via user interface: col. 79, lines 48-67 and col. 181, lines 5-15; also see col. 198, lines 2-67 and filter: col. 2, lines 55-67).

Mikurak discloses customizable software interface to communicate with the network. User who has a programmable smartcard would insert the smartcard to

communicating with system via smartcard reader and user would see the display with a plurality of selectable icon from which the user is able to select the desired icon for searching the database stored on the network with the filter. Mikurak does not clearly teach to establish the correspondingly reduced search space dependent upon said filter parameter.

However, Mikurak teaches the searching database with some filters to get the result (col. 180, lines 48-67, col. 181, lines 5-15 and col. 198, lines 2-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the graphical user interface, programmable smartcard, smartcard reader and icons for retrieving data stored in the database as taught by Mikurak because it would have made the system having a searchable database with the portable interface such as smart card with a card reader in the portable interface and the user is able to communicate directly with the network.

With respect to claim 2, Mikurak discloses wherein said data filter parameter comprises a base filter parameter, and wherein the PCFI is adapted to store another filter parameter which is combinable with said base filter parameter to thereby enable further reduction of tile dimension of the searchable database (col. 40, lines 45-55 and col. 81, lines 20-36).

With respect to claim 3, Mikurak discloses wherein said data filter parameter is a reference to said data filter parameter (col. 40, lines 45-55 and col. 181, lines 5-15).

With respect to claim 6, Mikurak discloses a programmable smartcard providing a user interface including at least one icon made visible on a surface of the smartcard,

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wherein the icon is capable is operable using a smartcard reader to which the smartcard is connected (a smart card is programmed: col. 256, lines 15-18) and icon for user to select: col. 14, lines 61-67 and col. 78, lines 4-11 and lines 24-38; smartcard reader for inserting the smartcard: col. 256, lines 25-30); a first data filter parameter and a first rule adapted to define a second data filter parameter dependent upon the first data filter parameter (col. 2, lines 55-67 and col. 181, lines 5-15).

Mikurak discloses customizable software interface to communicate with the network. User who has a programmable smartcard would insert the smartcard to communicating with system via smartcard reader and user would see the display with a plurality of selectable icon from which the user is able to select the desired icon for searching the database stored on the network with the filter. Mikurak does not clearly teach filter parameter.

However, Mikurak teaches the searching database with some filters to get the result (col. 180, lines 48-67, col. 181, lines 5-15 and col. 198, lines 2-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the graphical user interface, programmable smartcard, smartcard reader and icons for retrieving data stored in the database as taught by Mikurak because it would have made the system having a searchable database with the portable interface such as smart card with a card reader in the portable interface and the user is able to communicate directly with the network.

With respect to claims 7-9, Mikurak discloses the filter parameters (col. 40, lines 45-55 and col. 237, lines 40-67 and col. 238, lines 1-67).

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With respect to claim 10, Mikurak discloses configuring a Portable Customizable data Filter and Interface (PCFI) comprising a programmable smartcard adapted to store at least a data filter parameter, and further adapted to provide a user interface by means of spatially distributed user selectable icons made visible on a surface of the smartcard; interconnecting the PCFI to a searchable database; selecting one or more of said user selectable icons; and performing at least one of a database search and a data item selection, dependent upon said selection (Smart card is a piece of electronic equipment, which is programmed and produced portable programmed data carriers such as credit cards (personalization data): col. 256, lines 15-18; and icon for user to select: col. 14, lines 61-67 and col. 78, lines 4-11 and lines 24-38; smartcard reader for inserting the smartcard: col. 256, lines 25-30, also a graphical user interface for monitoring peripheral devices from which the user would select the options as depicting as graphical representation on the screen: col. 9, lines 32-48, col. 16, lines 37-67 and col. 237, lines 40-67 and col. 238, lines 1-67; also see abstract); filter parameter; col. 40, lines 45-55 and col. 181, lines 5-15).

Mikurak discloses customizable software interface to communicate with the network. User who has a programmable smartcard would insert the smartcard to communicating with system via smartcard reader and user would see the display with a plurality of selectable icon from which the user is able to select the desired icon for searching the database stored on the network with the filter. Mikurak does not clearly teach to establish the correspondingly reduced search space dependent upon said filter parameter.

However, Mikurak teaches the searching database with some filters to get the result (col. 180, lines 48-67, col. 181, lines 5-15 and col. 198, lines 2-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the graphical user interface, programmable smartcard, smartcard reader and icons for retrieving data stored in the database as taught by Mikurak because it would have made the system having a searchable database with the portable interface such as smart card with a card reader in the portable interface and the user is able to communicate directly with the network.

With respect to claims 11-12, Mikurak discloses reading the filter parameter, being a base filter parameter, from the PCFI; and applying the base filter parameter to the searchable database thereby to define the reduced search space; and wherein the step of performing one or more of a database search and a data item selection is followed, if further search space reduction is desired, by further steps of reading another filter parameter from -the PCFI; combining said other filter parameter with said base filter parameter; and applying the combined filter parameters to the reduced search, space thereby to define a further reduced search space and whereby said data filter parameter is a reference to said data filter parameter (col. 40, lines 45-55, col. 181, lines 5-15, col. 227, lines 42-60 and col. 229, lines 5-67; also see col. 237, lines 40-67 and col. 238, lines 1-67).

Claim 13 is essentially the same as claim 1 except that it is directed to a computer readable medium rather than a system, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 14 is essentially the same as claim 3 except that it is directed to a computer readable medium rather than a system, and is rejected for the same reason as applied to the claim 3 hereinabove.

With respect to claim 15, Mikurak a programmable smartcard that is operable using a smartcard reader to which the smartcard is connected; and a base data filter parameter stored in a memory of the smartcard wherein when the PFI is coupled to a database using the reader the search space of the database is reduced to a reduced search space according to the base data filter parameter (a smart card is programmed: col. 256, lines 15-18) and icon for user to select: col. 14, lines 61-67 and col. 78, lines 4-11 and lines 24-38; smartcard reader for inserting the smartcard: col. 256, lines 25-30); a first data filter parameter and a first rule adapted to define a second data filter parameter dependent upon the first data filter parameter (col. 2, lines 55-67 and col. 181, lines 5-15).

Mikurak discloses customizable software interface to communicate with the network. User who has a programmable smartcard would insert the smartcard to communicating with system via smartcard reader and user would see the display with a plurality of selectable icon from which the user is able to select the desired icon for searching the database stored on the network with the filter. Mikurak does not clearly teach the search space of the database is reduced search space according to the base data filter parameter.

However, Mikurak teaches the searching database with some filters to get the result (col. 180, lines 48-67, col. 181, lines 5-15 and col. 198, lines 2-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the graphical user interface, programmable smartcard, smartcard reader and icons for retrieving data stored in the database as taught by Mikurak because it would have made the system having a searchable database with the portable interface such as smart card with a card reader in the portable interface and the user is able to communicate directly with the network.

With respect to claim 16, Mikurak discloses a user interface including an icon made visible on a surface of the smartcard, wherein the icon is operable using the smartcard reader, and a second data filter parameter associated with the icon and stored in the memory, wherein selection of the icon associated with the second data filter parameter causes the reduced search space established by the base data filter parameter to be further reduced in accordance with to the second data filter parameter (graphical user interface: col. 9, lines 32-48 and col. 229, lines 5-67 and col. 230, lines 1-58; also see abstract; and col. 14, lines 61-67 and col. 78, lines 4-38; data filter parameters: col. 237, lines 40-67 and col. 238, lines 1-67).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 4-5 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Patent No. 6,671,818 issued to Mikurak.

With respect to claim 4, Mikurak discloses interfacing a customizing system to the PCFI and the PCUI using respective said smartcard readers (col. 256, lines 25-30); and programming the PCFI by means of user instructions being input to the customizing system using the user interface of the PCUI (custom software interface and graphical user interface: col. 2, lines 55-67 and col. 3, lines 1-5; also see abstract and col. 229, lines 5-67 and col. 230, lines 1-58).

With respect to claim 5, Mikurak discloses interfacing a customizing system to the PCFI using said smartcard reader (col. 256, lines 25-30); and programming the PCFI by means of user instructions being input to the customizing system using the user interface of the PCUI (custom software interface and graphical user interface: col. 2, lines 55-67 and col. 3, lines 1-5; also see abstract and col. 229, lines 5-67 and col. 230, lines 1-58).

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Contact Information

9. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527 via E-Mail: **ANH.LY@USPTO.GOV**. The examiner can be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Jonh Breene, can be reached on (703) 305-9790.

Any response to this action should be mailed to:


Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: (703) 872-9306 (Central Official Fax Number)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

AL 
FEB. 3rd, 2004


JEAN M. CORRIELLUS
PRIMARY EXAMINER